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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,596	02/15/2002	Bruce H. Hanson	FS-00655	9439
7590	07/28/2004		EXAMINER	
McGuireWoods LLP Suite 1800 1750 Tysons Boulevard Tysons Corner McLean, VA 22102-4215			MILLER, JONATHAN R	
			ART UNIT	PAPER NUMBER
			3653	
			DATE MAILED: 07/28/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/075,596	HANSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jonathan R. Miller	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 1/28/04.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 13-16 is/are allowed.

6) Claim(s) 1-12 and 17 - 22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 – 10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: optical edge recognition system. Without this element the apparatus cannot function. Applicant contends that this is not an essential feature for the invention to work. The Examiner disagrees. The invention sorts stacks of bound products by the location of the binding. This determination of the location of the binding is done by the optical edge recognition system. Without this system there is no way to determine the location of the bound edge. Applicant contends that the optical edge recognition system “is not required by the claimed invention to work in its intended manner” and that the system may work equally as well using “a known count of the product stacked in a certain orientation”. This constitutes new matter and is not proper. Using a known count is not taught in the specification. Nor is “using an operator determining the orientation of the edges”. The specification discusses the shortfalls of the prior art, pointing out that “manual operation is both time consuming and costly, thus increasing overhead and hence delivery rates.” Furthermore, Applicant cannot add new matter by a 132 affidavit.

3. Claims 17 – 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 17, the phrase “detecting a difference between edges” is indefinite. Further, in claim 20, the phrase “wherein the detecting step is based in a difference in

Art Unit: 3653

thickness between the edges" is indefinite. The language requires a comparison between edges.

Which edges are being compared? Is it different edges of one product in the stack, or is it a comparison of the same edge of adjacent products in the stack?

4. Claims 17 – 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: determining the position of the bound edge of the product. Applicant contends, "the recitation of 'bound' edges is not necessary." Examiner disagrees. The invention is based on the need to sort stacks of bound products into stacks so that their respective bindings are uniformly arranged in the completed stacks. Thus the independent claim must include a recitation of bound edges. Again, the Applicant attempts to improperly add new matter through the 132 affidavit. Applicant states that the stacks can be sorted based on "any feature". This is new matter, introduced by the 132 affidavit. Applicant cannot now point to the affidavit in an attempt to expand the scope of the invention beyond what was originally presented. Examiner contends the claims are still indefinite.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 5, 8, 11, 12 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Borchert et al. The reference discloses a plurality of compartments (Fig. 1), a plurality of moveable plates associated with each of the plurality of compartments (as shown in Fig. 1, the

Art Unit: 3653

plates for the central compartment are obviously shown and the plates for the side compartments are shown supporting the separated sheets – these are supported on springs {Fig. 1 clearly shows the plates placed upon springs (schematically represented)} and are moveable), and a stationary feed head mechanism positioned proximate a central compartment of the plurality of compartments (Fig. 1), the feed head mechanism being capable of transporting the products from the central compartment to remaining compartments of the plurality of compartments (col. 2, lines 1+), wherein the feed head mechanism allows the arrangement of products transported to the remaining compartments to be each stacked proximate the moveable plates (Fig. 1).

Examiner contends that the phase “oriented with bound edges in the homogeneous orientation” is intended use and is not afforded patentable weight.

7. With regards to claim 2, the reference further discloses the feed head mechanism separately transports each of the products from the central compartment to the remaining compartments (col. 2, lines 1+). Applicant contends that the side stacks are not held in “compartments”. Examiner disagrees. What is a compartment? How can the Applicant state that these elements “clearly are not compartments”.

8. With regards to claim 3, the reference further discloses the central moveable plate supports the products (Fig. 1). Examiner contends that the phase “which have bound edges oriented in opposing directions” is intended use and is not afforded patentable weight.

9. With regards to claim 4, the reference further discloses the plurality of compartments includes the central compartment and opposing side compartments (Fig. 1). Applicant contends that the side stacks are not held in “compartments”. Examiner disagrees. What is a compartment? How can the Applicant state that these elements “clearly are not compartments”.

Art Unit: 3653

10. With regards to claim 5, the reference further discloses the feed head mechanism comprising a belt driven transportation mechanism having a plurality of suction ports and a vacuum source in communication with the plurality of suction ports (col. 2, lines 1+).

11. With regards to claim 8, the reference further discloses moveable walls separating each of the plurality of compartments. These walls are shown in Fig. 1. The center compartment has moveable walls that move up and down with the elevator. The walls of the outer compartments are shown attached to the plates, referenced above. These walls separate each of the compartments.

12. With regards to claim 11, the reference further discloses the feed head mechanism includes an optical edge recognition system (col. 1, lines 40+). Examiner contends that the phase “for detecting a bound edge of the product” is intended use and is not afforded patentable weight.

13. With regards to claim 12, the reference further discloses that information is received from the optical edge recognition system is used for separately transporting products of the stack from the central compartment to the remaining compartments which are opposing side compartments (col. 1, lines 40+). Examiner contends that the phase “thereby orienting the stack of products on each of the opposing side compartments with bound edges in the homogenous orientation” is intended use and is not afforded patentable weight.

14. With regards to claim 22, the reference discloses the plates include a center plate and two opposing side plates, the center plate moveable in a first direction and the two opposing side plates moveable in a second opposing direction. As shown in Fig. 1, the plates for the central compartment are obviously shown and the plates for the side compartments are shown supporting the separated sheets – these are supported on springs and are moveable. Fig. 1 clearly

shows the plates placed upon springs (schematically represented). The Examiner contends that the schematic representations of the springs is commonly accepted in the art. As products are removed from the center stack the plate moves upward, and as the products are placed upon the side compartments the weight of the products causes the springs to compress and the side plates to move downwardly. This is inherently shown.

***Allowable Subject Matter***

15. Claims 13- 16 are allowed.

***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan R. Miller whose telephone number is (703) 305-5778. The examiner can normally be reached on M-F: 8:30AM-5:00PM.

Art Unit: 3653

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703) 306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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